

ADJUDICATOR DECISION

CASE NUMBER:	ZA2010 - 0048
DECISION DATE:	23 September 2010
DOMAIN NAME	etravelmag.co.za
DOMAIN NAME REGISTRANT:	Nuttall, Paul
REGISTRANT'S LEGAL COUNSEL:	N/A
THE COMPLAINANT:	E Travel (Pty) Ltd
COMPLAINANT'S LEGAL COUNSEL:	André van der Merwe (D M Kisch Inc)
THE 2 nd LEVEL DOMAIN NAME ADMINISTRATOR:	UniForum SA (CO.ZA Administrators)

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1) Procedural History

- a. The Dispute was filed with the South African Institute of Intellectual Property Law (the "SAIPL") on 24 June 2010. On 30 June 2010 the SAIPL transmitted by email to UniForum SA a request for the registry to suspend the domain name at issue, and on 30 June 2010 UniForum SA confirmed that the domain name had indeed been suspended. The SAIPL verified that the Dispute satisfied the formal requirements of the .ZA Alternate Dispute Resolution Regulations (the "Regulations"), and the SAIPL's Supplementary Procedure.
- b. In accordance with the Regulations, the SAIPL formally notified the Registrant of the commencement of the Dispute on 8 July 2010. In accordance with the Regulations the due date for the Registrant's Response was 4 August 2010. The Registrant submitted a defective Response on 28 July 2010, and the SAIPL notified the Respondent on 11 August 2010 that the reply was defective. The SAIPL furthermore referred the Registrant to Regulation 18 of the Rules giving notice of the fact that a proper (full) response had not been received and that, should the full response not be forthcoming, the SAIPL will have no other option but to appoint an adjudicator in this regard. The SAIPL did not forward a copy of the Response to the Complainant. However

due to the nature of the response the adjudicator is of the view that this in no way prejudiced the Complainant's rights as the Complaint document in any event anticipated and dealt with the relevant issues.

- c. The SAIPL appointed Professor Wim Alberts (assisted by Renée Luus) as the Adjudicator in this matter on 11 August 2010. The Adjudicator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the SAIPL to ensure compliance with the Regulations and Supplementary Procedure.

2) Factual Background

- a. On 12 February 1999 the Complainant was registered and incorporated as a private company in terms of the Companies Act of 1973 under registration number 1999/003053/07.
- b. Since that date Complainant has been offering a range of travel services to the South African market which includes, but is not limited to, tour operations including outbound and inbound travel, corporate travel solutions and on-line travel products.
- c. In addition the Complainant company offers independent travel companies an opportunity to empower themselves through the internet.
- d. The Registrant is seemingly involved as editor and publisher with the Strega Publishing Group which, according to information available in the public domain, provide publishing services on a contractual basis to companies and organisations who wish to hire out some or all parts of the publishing process.
- e. The Complainant became aware of the Registrant's registered Domain name during the latter part of 2008, alternatively, early 2009. Consequently, the Complainant, through its attorneys DM Kisch Incorporated, sent a letter of demand to the Registrant on

16 April 2010 referring the Registrant to the Complainant's rights (which will be dealt with fully below) and requesting the Registrant to immediately cease use of the Domain name.

- f. No reply was received from the Registrant and the Complainant subsequently lodged a complaint with the SAIPL on 24 June 2010.
- g. On 28 July 2010 the Registrant replied to the allegations contained in the Complaint and briefly stated that, *inter alia*, the term used for the website is a generic term (the words in the email states that: "You cannot trademark (sic) a generic term") and that the names and logos are not similar. This aspect is dealt with more fully below.

3) Parties' Contentions

a. Complainant

The Complainant has made the following submissions:-

- i. That the Complainant registered the **E-TRAVEL** name as the company / business / trade name of its operations on 12 February 1999 in terms of the Companies Act of 1973;
- ii. That the Complainant is the proprietor of the **E-TRAVEL** trade mark (registered in classes 9, 35, 36, 39 and 43);
- iii. That the Complainant is the proprietor of the **POINT.CLICK.GO.E HOLIDAYS** and **E&Device** marks (in classes 9, 36, 39 35 and 43 respectively) as applications for registration of these marks have been lodged with the Registrar of Trade Marks;
- iv. That the Complainant enjoys common law rights by virtue of the fact that the **E-TRAVEL** name is recognised in the travel agent industry;

- v. That the disputed domain name **etravelmag.co.za** is identical or, alternatively, confusingly similar to the names and marks to which the Complainant have rights and that the additional descriptive word (“mag” short for “magazine”) which had been added to the **E-TRAVEL** name is merely generic;
- vi. That the Registrant has failed and refused to comply with the Complainant’s demands (contained in its letter of demand dated 16 April 2010); and
- vii. That the disputed domain name, in the hands of the Registrant, is an abusive registration due to the facts that:-
 - The registration of the disputed domain name unfairly disrupts the business of the Complainant;
 - The registration of the disputed domain name has the effect that the Complainant is barred from registering the name of its business in the form of a further line of extension of its business activities;
 - That use of the Domain name by the Registrant leads people or businesses to believe that the Domain name is registered to, operated or authorised by or otherwise connected with the Complainant.

b. Registrant

- i. The Registrant failed to provide a comprehensive response. The Registrant’s submissions were contained in two short emails which stated:-
 - Firstly that the trade mark is generic (as it refers to etravel). I assume that the Registrant is referring to

the term “e” and the fact that, the “e” can be argued to mean “electronic” or any other suitable abbreviation;

- Secondly, the Registrant indicated that the trade marks did not appear when conducting a CIPRO search and that, in addition to the marks not appearing in a CIPRO search, the marks *“nevertheless will be in a different category”*;
- That the Complainant and the Registrant had different names and that the *“logos do not clash”*;
- That the Registrant did not deliberately register the Domain name to capitalize on the Complainant’s rights (as the Registrant were not aware of the Complainant at the time the Domain name was registered);
- That the Complainant was upset due to the fact that the Registrant had been engaged in a deal with competitors of the Complainant (Sure Travel);
- That it would be a major inconvenience to change all stationery, domain names, banner ads etcetera; and
- That its services are not related to or associated with travel.

ii. This was the sum total of the submissions made by the Registrant.

4) Discussion and Findings

Before dealing with the substantive issues it is important to indicate that the Registrant did not present any arguments questioning the legal

authority or jurisdiction of the SAIPL. In addition, the response received (in one of the emails as referred to in Para 3 above) indicated that the Registrant affirmed that the matter should be adjudicated by the SAIPL.

The adjudicator will now deal with the substantive issues contained in the current dispute.

Regulation 3 of the Alternative Dispute Resolution Regulations (promulgated in November 2006 and read with section 90 of the Electronic Communications and Transactions Act 25 of 2000) states that, in order for a Complainant to prove the existence of an Abusive registration, the Complainant is required to prove, on a balance of probabilities, that:

- The Complainant has rights in respect of the name or mark;
- The name or mark is identical to the domain name; and
- That the domain name, in the hands of the Registrant is an Abusive registration.

b. Complainant's Rights

- i. The Regulations require the Complainant to establish that it has rights in respect of a name or mark. An Appeal Adjudication Panel has indicated that the "balance of probabilities" under regulation 3(1)(a) involves a fairly low evidentiary burden for the Complainant to meet (see: *Allstates Global Karate Do, Inc d.b.a World Seido Karate Organisation v Suids Karate* APZA2009-0030 at 12).
- ii. The Complainant has registered rights in the trade mark **E-TRAVEL** that dates back to 1999 and are *prima facie* valid and enforceable. These marks are the following:
 - **E-TRAVEL**, registration no. 1999/17875 in class9;

- **E-TRAVEL**, registration no. 1999/17876 in class 35;
 - **E-TRAVEL**, registration no. 1999/17877 in class 36;
 - **E-TRAVEL**, registration no 1999/17878 in class 39;
and
 - **E-TRAVEL**, registration no 1999/17879 in class 43.
- iii. In addition the Complainant has applied for registration of the **POINT.CLICK.GO.E HOLIDAYS** and **E&Device** trade mark applications, the details of the registrations are:
- **POINT.CLICK.GO. EHOLIDAYS**, no 2004/11182 in class 9;
 - **POINT.CLICK.GO. EHOLIDAYS**, no 2004/11183 in class 35;
 - **POINT.CLICK.GO. EHOLIDAYS** no 2004/11184 in class 36; and
 - **POINT.CLICK.GO. EHOLIDAYS** no 2004/ 11185 in class 39.
 - **E & Device**, no 2008/22815 in class 9;
 - **E & Device**, no 2008/22816 in class 35;
 - **E & Device**, no 2008/22817 in class 36;
 - **E & Device**, no 2008/22818 in class 39; and
 - **E & Device**, no 2008/22819 in class 43.
- iv. Section 34 of the Trade Marks Act 194 of 1993 provides the Complainant with statutory rights and protection.
- v. The rights protected under the Regulations include intellectual property rights and commercial rights

protected by South African Law. In *Telkom SA Ltd v Cool Ideas CC ZA 2007-0003* the adjudicator held that trademark registrations for TELKOM that are *prima facie* valid and enforceable have to be taken into account. The adjudicator in the Telkom case similarly held that the registrations provided the complainants with rights in terms of section 34 of the Trade Marks Act that could be enforced in the case of infringement.

- vi. Accordingly the **E-TRAVEL** mark is protected by statute in terms of section 34 of the Trade Marks Act. It is important to note that the specification of for instance, the **E-TRAVEL**, registration no. 1999/17876 in class 35 refers to “*provision of sale and trading points and localities for electronic and other trade, particularly in relation to travel...*”. This could be seen to provide them with rights in relation to similar goods (see New Media Publishing (Pty) Ltd v Eating Out Web Services 2005 (5) SA 388 (C)) and in particular, magazines.
- vii. Where a trade mark (**E-TRAVEL**) is registered as a domain name, the proprietor may rely on statutory trade-mark infringement (see Pistorius “Cyberbusters versus Cybersquatters, Round II in The Zadna Ring” SA Merc Law Journal 2009 665).
- viii. The Claimant has accordingly established that the required elements of “rights” in relation to the **E-TRAVEL** mark have been met.
- ix. Based on the evidence presented, the adjudicator is satisfied that the Complainant has satisfied the rights element on a balance of probabilities.
- x. However, in the interest of justice I will deal with the general allegation made by the Registrant that the domain

name is generic in nature. The trade mark **E-TRAVEL** has been registered (in classes 9, 35, 36, 39 and 43) and accepted by the Registrar of Trade Marks in 1999. These facts are not disputed (although the Registrant indicated that no proof could be found on CIPRO the adjudicator found all marks referred to in the Complaint on the CIPRO website).

- xi. In terms of section 9 of the Trade Marks Act a trade mark has to be capable of distinguishing the goods or services of the applicant in order to be registered. *In casu* the Registrar of Trade Marks decided that **E-TRAVEL** meets this criterion for registration and accordingly granted registration. Any objections in relation to the registration of the mark should have been presented before the appropriate forum (which is the Registrar of Trade Marks) during the process of registration and after the mark was advertised.
- xii. Under the circumstances the adjudicator cannot comment on the distinctiveness of the mark, and has to accept the statutory validity of the registered marks as envisaged in the Trade Marks Act.
- xiii. The disputed domain name **etravelmag.co.za** contains the Complainant's name and trade mark **E-TRAVEL** in its entirety. The trade mark is the dominant feature of the disputed domain name. The Registrant added a descriptive / generic term "mag" to the Complainant's mark, which we assume stands for "magazine".
- xiv. In NAF/FA141825 it was held that: "[It] is also well - established under the Policy that a domain name composed of a trademark coupled with a generic term still is confusingly similar to the trademark". Similarly in

WIPO/S2002-0367 the Panel concluded that “The Disputed domain name contains Complainant’s EXPERIAN trademark in its entirety. The addition of the generic terms “automotive” does not distinguish Respondent’s domain name from the Complainant’s mark”.

xv. I therefore find, on a balance of probabilities, that the Complainant’s trade mark E-TRAVEL is similar to the Disputed domain name.

c. Abusive Registration

i. Regulation 4 (1) (a) lists factors that may indicate that the domain name is an abusive registration. Some of the circumstances that will indicate whether a Registrant has registered or otherwise acquired the domain for purposes of an Abusive Registration are:

- If a Registrant sells, rents or otherwise transfers the domain name for valuable consideration in excess of the registrant’s reasonable out-of-pocket expenses directly associated with acquiring or using the domain name;
- If a Registrant intentionally block the registration of a name or mark in which the complainant has rights;
- Where a Registrant unfairly disrupts the business of the complainant; or
- Where a Registrant prevent the complainant from exercising its rights.

ii. The Complainant did not rely on grounds 1 and 2 above.

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- iii. The Complainant alleged that the registration is abusive as it unfairly disrupts the business of the complainant and prevent the complainant from exercising its rights.
 - iv. It is accepted that the Complainant is in the travel business, has registered a number of trade marks for **ETRAVEL**, has established rights in respect of certain forms of media and has a legitimate expectation of expanding to other forms of media.
 - v. Due to this, the adjudicator is of the view that the registration is abusive as it unfairly disrupts the business of the Complainant by preventing its expansion. Similarly it prevents the Complainant from exercising its rights.
 - vi. In addition the Registrant is furthermore preventing the Complainant from exercising its rights by incorporating the mark / name of the Complainant (which is protected under statute) in the Disputed Domain name.

5) Decision

For all the foregoing reasons, in accordance with Regulation 9, the Adjudicator orders that the domain name, **etravelmag.co.za** be transferred to the Complainant.

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Professor Wim Alberts

Assisted by: Renée Luus

SAIPL SENIOR ADJUDICATOR

www.DomainDisputes.co.za